



DOCKET NO: 247342US8

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
JOHN MARTIN : EXAMINER: UNASSIGNED  
SERIAL NO: 10/749,401 :  
FILED: JANUARY 2, 2004 : GROUP ART UNIT: 2131  
FOR: ELECTRONIC ARCHIVE FILTER :  
AND PROFILING APPARATUS,  
SYSTEM, METHOD, AND  
ELECTRONICALLY STORED  
COMPUTER PROGRAM PRODUCT

PETITION UNDER 37 C.F.R. § 1.47

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

John Martin, the sole named inventor of the above-identified patent application, has refused to sign a Rule 1.63 oath or declaration for the above-identified application.

CRICKET TECHNOLOGIES L.L.C. (hereinafter Applicants) hereby petitions, under 37 C.F.R. § 1.47, that the U.S. PTO provide a filing receipt acknowledging that all formal requirements have been met for obtaining a filing date of January 2, 2004 for the above-identified application and that the above-identified application proceed to examination.

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## **I. Introduction**

MPEP § 409 identify the following requirements for a petition under 37 C.F.R. § 1.47:

- Provision of a summary of facts relating to the inventor's refusal to sign (MPEP § 409.03(d)).
- Provision of the last known address of the inventor (MPEP § 409.03(e)).
- Proof of proprietary interest (MPEP § 409.03(f)).
- Proof of irreparable harm (MPEP § 409.03(g)).
- Payment of a fee under 37 C.F.R. § 1.17(h).

## **II. Summary Of Facts Relating To The Inventor's Refusal To Sign**

Mr. Martin is the sole inventor of at least one claim in the subject application. As set forth in Attachments A-C attached hereto, efforts have been made to obtain Mr. Martin's signature on a Rule 1.63 oath or declaration document and on an assignment document.

The present application claims priority to a provisional application (Application Ser. No. 60/437,440) filed on January 2, 2003. Mr. Martin signed an assignment for this provisional application (Attachment A, ¶ 2). After the subsequent utility application was filed, Mr. Martin did not sign the declaration and assignment (Attachment B, ¶ 3).

In view of this situation, Bradley D. Lytle, Esq. of Oblon, Spivak, Maier, McClelland & Neustadt P.C., IP counsel for CRICKET TECHNOLOGIES L.L.C., spoke with Mr. Martin via telephone on July 28, 2004 (Attachment B, ¶ 4), where Mr. Martin expressed an understanding of the issue and a willingness to sign the declaration if so advised by his attorney. Mr. Martin informed Mr. Lytle that he would have his attorney, Mark Wishner, Esq. of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C., contact Mr. Lytle with an

answer. Having not been contacted by Mr. Martin's attorney on August 17, 2004, Mr. Lytle contacted Mr. Wishner by telephone, (Attachment B, ¶ 5), resulting in Mr. Wishner indicating that he understood the issue and agreeing to discuss this matter with Mr. Martin. Receiving no reply from Mr. Wishner or Mr. Martin, Mr. Lytle sent a letter to Mr. Wishner via UPS on September 2, 2004 (Attachment B, ¶ 6) repeating Mr. Lytle's previous verbal requests for a signature on a Rule 1.63 oath or declaration. To date, neither Mr. Martin nor Mr. Wishner has returned a signed a Rule 1.63 oath or declaration to Oblon Spivak or CRICKET TECHNOLOGIES L.L.C. for filing with the U.S. PTO.

### **III. Last Known Address Of The Inventor**

Mr. Martin's last known mailing address is 17100 Paloma Circle, Round Hill, VA 20141. The mailing address of Mr. Martin's last known attorney is Mark Wishner Esq., Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C., 12010 Sunset Hills Road, Suite 900, Reston, Virginia 20190-5839.

### **IV. Proof of Proprietary Interest**

At least from August 7, 2001 until his termination on August 4, 2004, Mr. Martin was under an obligation to assign his rights to all intellectual property created, including the above-identified application, to Applicants (CRICKET TECHNOLOGIES, L.L.C.) as evidenced by a Memorandum of Understanding (MOU) signed by Mr. Martin on August 7, 2001 (Attachment C). Through this MOU, Mr. Martin contractually obligated himself to transfer ownership of any intellectual property that he created after August 7, 2001 to CRICKET TECHNOLOGIES L.L.C. while an employee therein (Attachment C, ¶ 4). In view of this MOU, and because the subject matter of the present application was invented between August 7, 2001 until his termination on August 4, 2004, it is respectfully submitted that

CRICKET TECHNOLOGIES L.L.C. has a proprietary interest in the pending utility application.

Applicants (CRICKET TECHNOLOGIES L.L.C.) further assert that they have a proprietary interest in the pending utility application in view of the assignments of rights signed by Mr. Martin relative to provisional Application Ser. No. 60/437,440, which was filed on January 2, 2003 and which is the priority document for the inventions claimed in the present application.

**V. Proof of Irreparable Harm**

A grant of petition under 37 C.F.R. § 1.47 is requested in order to preserve Applicants' original filing date of January 2, 2004, thus preventing Applicants from suffering irreparable damage by way of abandonment of Applicants' application for a patent.

**VI. Payment of a fee under 37 C.F.R. § 1.17(h)**

The fee identified in 37 C.F.R. § 1.17(h) is attached herewith.

**VII. Conclusion**

In view of the preceding information and supporting Attachments, it is respectfully submitted that the requirements of 37 C.F.R. § 1.47 and MPEP § 409 have been met. Therefore, Applicants request that Mr. Martin be designated as a non-signing inventor under 37 C.F.R. § 1.47 and that the U.S. PTO provide a filing receipt acknowledging that all formal requirements have been met for obtaining the January 2, 2004 filing date, thereby allowing

Application No. 10/749,401  
Petition under 37 CFR. § 1.47

the above-identified application to proceed to examination without Mr. Martin's signature to  
an oath or declaration under 37 C.F.R. § 1.63.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Registration No. 40,073  
Attorney of Record  
Michael E. Monaco  
Registration No. 52,041

Customer Number

**22850**

Tel No. (703) 413-3000

Fax No. (703) 413-2220

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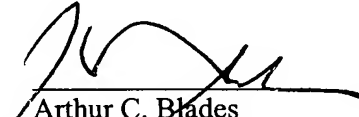
ATTACHMENT A TO  
PETITION UNDER 37 C.F.R. § 1.47

DECLARATION OF ARTHUR C. BLADES

Pursuant to 28 U.S.C. § 1746, I, Arthur C. Blades, make the following statement.

1. I am a United States citizen and a resident of Fairfax County, Virginia, U.S.A. I am a retired Lt. General of the United States Marine Corps and the organizer, President and a Manager of Cricket Technologies, LLC (hereinafter "Cricket" or "the Company")
2. In July 2002, the Board of Managers, including John Martin, voted to task outside counsel to prepare a provisional patent application directed to what became known as the "Cricket Mail Manager" product. John Martin participated in various meetings and discussions with counsel regarding the preparation of this provisional application. This provisional application was filed on January 2, 2003 (Application Ser. No. 60/437,440). On or about December 20, 2002, John Martin signed an assignment for this first provisional application. The signed assignment was filed with the U.S. PTO on January 2, 2003.
3. In December 2003, the Board of Managers of Cricket Technologies directed counsel to proceed with preparing and filing a utility application directed to the "Cricket Mail Manager" product (eventually becoming Application Serial No. 10/749,401).

4. On or about August 4, 2004, the majority of the Board of Managers voted to terminate their contract with John Martin for cause.
5. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.



Arthur C. Blades  
President and Manager  
Cricket Technologies LLC

Dated: 11/11/04

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ALEXANDRIA, VIRGINIA 22313

SIR:

ATTACHMENT B TO  
PETITION UNDER 37 C.F.R. § 1.47

DECLARATION OF BRADLEY D. LYTLE

Pursuant to 28 U.S.C. § 1746, I, Bradley D. Lytle, make the following statement.

1. I am a United States citizen and a resident of Loudoun County, Virginia, U.S.A. I am member at Oblon, Spivak, Maier, McClelland & Neustadt, P.C. (hereinafter "Oblon Spivak"), which provides IP services to Cricket Technologies L.L.C. (hereinafter "Cricket").
2. On or about June 2002, in-house counsel of Cricket requested Oblon Spivak to prepare and file a provisional patent application. This application was filed on January 2, 2003, eventually being designated as Application Ser. No. 60/437,440 and eventually referred to by Cricket as "Mail Manager". On December 20, 2002, John Martin signed an assignment for this provisional application. The signed assignment was duly filed with the U.S. PTO on January 2, 2003.
3. On or about December 2003, in-house counsel of Cricket requested Oblon Spivak to prepare and file a utility application, based on the previously identified provisional application. Mr. Martin worked with a colleague of mine to prepare the utility application. This application was filed on January 2, 2004, eventually receiving a serial number of 10/749,401. Oblon Spivak received no declaration or assignment forms signed by John Martin for this application.



4. On July 28, 2004, I was asked by in-house counsel of Cricket to contact John Martin in view of the fact that John Martin refused requests by Cricket to sign the declaration and assignment forms. I wanted to personally explain to Mr. Martin the need for Mr. Martin to sign the declaration and to clarify that the declaration and assignment are different documents. Thus, on July 28, 2004, I contacted Mr. Martin by telephone and explained the need for him to sign the declarations for both this and another application (App. Ser. No. 10/821,949). Mr. Martin explained that he was not interested in creating a new "asset" that would further complicate discussions regarding his possible separation from Cricket. I explained to him that we were not asking him to sign an assignment at this time, but only a declaration so that the two applications would remain pending. Mr. Martin replied that he understood the difference between a declaration and an assignment and that he would contact his attorney (Mark Wishner, Esq. of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.) who, in turn, would contact me if his attorney agreed it was in Mr. Martin's interest to do so.
5. Not hearing from Mr. Martin or his attorney in a timely manner, I contacted Mr. Martin's attorney, Mr. Wishner, on August 17, 2004. I explained to Mr. Wishner the need for John Martin to sign the declarations for both this and the other application (App. Ser. No. 10/821,949) so that these applications could be prosecuted in the U.S. PTO. I relayed Mr. Martin's explanation that Mr. Martin planned to meet with Cricket managers to discuss his possible departure from Cricket, and thus, was not interested in creating a new "asset" that would further complicate these discussions. I explained to Mr. Wishner that we were not asking Mr. Martin to sign an assignment at this time, but only a declaration so that the two applications would remain pending. Mr. Wishner replied that he understood the difference between a declaration and an assignment and that he would advise Mr. Martin to sign the declarations if he and Mr. Martin concluded it was in Mr. Martin's best interest to do so.
6. Not hearing from Mr. Wishner in a timely manner, I sent a letter to Mr. Wishner via UPS on September 2, 2004, attached hereto as Exhibit 1 with one final request for Mr. Martin to sign the Declaration. This UPS package included copies of the Declaration, Specification, Figures, and Claims for this application. Proof of delivery of this mailing is attached hereto as Exhibit 2. No response has been received to the letter of September 2, 2004.
7. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

  
\_\_\_\_\_  
Bradley D. Lytle

Dated: 11/22/04

Exhibit 1 of attachment B

September 2, 2004



VIA UPS

Mark Wishner Esq.  
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.  
12010 Sunset Hills Road  
Suite 900  
Reston, Virginia 20190-5839

**COPY**

BRADLEY D. LYTLE  
(703) 412-6489  
BLYTLE@OBLON.COM

MICHAEL E. MONACO  
REGISTERED PATENT AGENT  
(703) 413-3000  
MMONACO@OBLON.COM

Re: U.S. Application  
Serial Nos. 10/749,401; and  
10/821,949  
Our Refs: 247342US-238100-238100-8; and  
250727US-238100-238100-8

Dear Mark:

Further to our conversation on August 17, 2004, please find attached to this letter two declaration forms that we respectfully ask John to sign and return to us as soon as possible. These forms are declarations under 37 C.F.R. § 1.63 which are required by the U.S. Patent Office in the matters of U.S. Patent Application Serial Nos. 10/749,401, our 247342US and 10/821,949, our 250727US, John would recognize these applications as the "Mail Manager" and "QC" patent applications, respectively. We have also attached the filed specifications, along with a preliminary amendment relative to the "QC" application, for John's review prior to signing the declarations.

As we discussed during our phone conversation, these declarations are not assignments of ownership and do not imply a transfer of any ownership rights of any inventions disclosed in the patent applications. The declarations in question must be filed to keep the applications 'alive' in the PTO. This will allow time for resolution of the dispute between John and Cricket with respect to ownership of these patent applications.

As an inventor, we believe it is in John's best interest, as well as Cricket's, for John to sign the attached declarations so as to prevent the applications from being abandoned. John and Cricket may later negotiate the assignments if the applications are pending, but if the applications become abandoned for failure to file the declarations, there will be no intellectual property assets for either party.

As we have a pressing deadline with the U.S. PTO for these documents, we respectfully request that we received signed copies by September 1, 2004. If we do not receive signed copies of these forms, we will take steps under 37 CFR § 1.47 to keep the

Page 2

Mark Wishner Esq.

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.

application alive. This procedure is time-consuming and costly and, thus, may negatively affect any future settlement between John and Cricket. Therefore we strongly recommend that John sign these papers so both parties may avoid unnecessary patent application processing expenses.

Please let us know if you have any questions or comments regarding this matter.

With best regards,

Very truly yours,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

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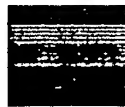
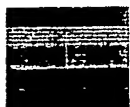
Bradley D. Lytle

BDL/MEM/kkn

Enclosures: Declarations for 250727US and 247342US  
Specifications, Figures, Claims for 250727US and 247342US  
Preliminary Amendment for 250727US

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Exhibit 2 of attachment B

**Shipping**

- [Begin Your Shipment](#)
- [View History or Void Shipment](#)
- [Shipping Preferences](#)

→ [Help](#)

## View History or Void Shipment

Use this history to review, track, and void your previous shipments. You can also re-ship using the information from a previous shipment. Any changes you make to how your history is displayed are automatically saved.

### History Selections

[Change Shipping History View](#)[Export Current View](#)

Display Per Page:

☒ 25 Shipments

Show History For the Last:

☒ 30 Days

### Previous Shipments

Please select an individual shipment using the checkboxes. You can then choose to View details concerning that shipment, Void the shipment, or Ship again using the appropriate buttons.

Also, use the checkboxes to select one or more packages on this page (maximum 1), and select Track to display tracking details for these items.

**Shipments 1 through 1 out of 1 in the last 30 Days**[Show Detail/Receipt](#) [Track](#) [Ship Again](#) [Void Ship](#)

<input type="checkbox"/>	<a href="#">Shipped Date</a>	<a href="#">Ship To - Company or Name</a>	<a href="#">Service</a>	<a href="#">Shipment Tracking #</a>
<input checked="" type="checkbox"/>	02 Sep 2004	MINTZ, LEVIN, COHN, FERRIS, P.C.	UPS Next Day Air	1ZW2A4910194428079

**Shipments 1 through 1 out of 1 in the last 30 Days**[Show Detail/Receipt](#) [Track](#) [Ship Again](#) [Void Ship](#)**Company Support: 703-413-2727 [ajones@oblon.com](mailto:ajones@oblon.com)**



**ATTACHMENT C  
TO PETITION UNDER 37 C.F.R. § 1.47**

Attachment C

MEMORANDUM OF UNDERSTANDING REGARDING CAPITAL INVESTMENTS BY  
MERLIN.COM, ARTHUR C. BLADES, AND JOHN MARTIN IN CRICKET TECHNOLOGIES, LLC

Whereas John Martin and Arthur C. Blades (Martin and Blades) have negotiated their voluntary separation as members and managers of Elmstreet Technology Group, LLC (ETG) a company providing information management services (August 2 Agreement) (Attachment A);

Whereas the August 2 Agreement, expressly permits Martin and Blades to use their unaided memories in creating new intellectual property to compete with ETG provided they have not copied, memorized, or otherwise used ETG's intellectual property;

Whereas Martin and Blades have established Cricket Technologies, LLC (Cricket) a technology company that may compete with ETG without use of any ETG proprietary information and in accordance with the settlement agreement with ETG;

Whereas counsel specializing in intellectual property law has provided Cricket with a legal opinion that Martin may follow certain procedures in developing new intellectual property without infringing on the rights of ETG under the August 2 Agreement or otherwise (Attachment B);

Whereas Merlin.com, by its President Charles F. Smith, is interested in investing in Cricket;

Whereas the parties have had numerous discussions regarding Smith's investment and the operation of Cricket;

Therefore, upon the following consideration, the parties agree as follows:


1. Merlin.com will contribute \$200,000.00 to Cricket in installments as provided in Attachment C and provide for a line of credit of an additional \$100,000.00 as debt in a form as attached as Attachment D;
2. Cricket will operate in accordance with the Operating Agreement that is attached hereto as Attachment E;
3. The new company will enter into employment agreements with Martin, Blades, and Smith that are attached hereto as Attachments F, G, and H;
4. Martin agrees that any intellectual property he creates after the date of this agreement will be owned by and will be assigned to Cricket, and is "works made for hire," as that term is defined in the United States Copyright Act (17 U.S.C. § 101), provided that, if Cricket elects in writing not to use the intellectual property after Martin gives it written notice and reasonable opportunity to consider, Martin will have the right to use it elsewhere in accordance with the Operating Agreement; otherwise, Martin has agreed to assign to Cricket any rights he may have or acquire in any intellectual property and to cooperate to the fullest extent in securing Cricket's ownership rights in any intellectual property he creates or conceptualizes. Intellectual property means improvements, inventions, designs, ideas, works of authorship, copyrightable works,


discoveries, trademarks, copyrights, trade secrets, formulas, processes, techniques, know-how, and data, whether or not patentable, made, or conceived or reduced to practice or learned during the period of Martin's employment. Martin also agrees to fully cooperate with Cricket in obtaining and/or enforcing patents, copyrights, or other rights in intellectual property Martin has created under this agreement and irrevocably appoints Cricket and its duly authorized officers and agents as his agent and attorney-in-fact, to do all lawfully permitted acts to further the prosecution and issuance of letters patent, copyright, or other analogous protection thereon with the same legal force and effect as if executed by me.


5. Martin and Blades will assign to Cricket as their capital contributions all receivables assigned to them by ETG under the August 2, 2001 settlement agreement (Attachment A);

6. Cricket Technologies, LLC will make sales the top priority of the company, which means, among other things, that within the first month of operations, Cricket will hire a sales manager at a competitive salary and will allocate funds of at least 8 % of gross sales revenue during the first year of operation to its marketing budget for advertising and hiring of a public relations consultant and related services;

Agreed this 7<sup>th</sup> day of August, 2001:

  
Arthur C. Blades

  
John Martin

  
Charles E. Smith